

AB-334U

10/642,851

REMARKS

This is a full and timely response to the non-final Official Action mailed February 12, 2007. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Interview:

Applicant wishes to thank the Examiner for taking time to conduct a telephonic interview regarding this application on May 10, 2007. During the interview, the Examiner noted that the Office had made an error in indicating that claim 15 was allowable in the recent Office Action. The Examiner further noted that claim 15 would be held allowable if the limitations of independent claim 16, from which claim 15 depends, were incorporated into claim 15. Proposed amendments to claims 10 and 16 were also discussed, including the arguments presented below in favor each of these claims. While no agreement was reached on the allowability of any claim, the Examiner's insights and comments were most helpful in preparing this paper.

Claim Status:

By the foregoing amendment, various claims have been amended. No claims have been canceled. Claims 1, 3-4, 6, 8-9, and 14 were canceled previously. New claims 25-27 have been added. However, no new subject matter has been added. Thus, claims 2, 5, 7, 10-13, and 15-27 are currently pending for the Examiner's consideration.

AB-334U

10/642,851

Allowable Subject Matter:

In the recent Office Action, the Examiner allowed claims 2, 5, 7, 12, 13, and 21-24. Applicant wishes to thank the Examiner for the allowance of these claims. The Office Action also contains a statement of reasons for the allowance of these claims. Applicant agrees with the Examiner's conclusions regarding patentability, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant believes that the application is allowable because the prior art fails to teach, anticipate or render obvious the invention as claimed, independent of how the invention is paraphrased.

The Examiner also indicated the presence of allowable subject matter in claim 15 during the interview of May 10, 2007. Accordingly, claim 15 has been amended herein and rewritten in independent form. Consequently, based on the Examiner's finding of patentable subject matter, claim 15 should be in condition for immediate allowance following entry of the present amendment.

Claim Objections:

Claim 5 was objected to for including an inadvertent typographical error. Accordingly, claim 5 has been amended to address this inadvertent error. Following entry of this amendment, claim 5 should be in condition for allowance, and notice to that effect is respectfully requested.

AB-334U

10/642,851

Prior Art:

Claims 16-17 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,927,277 to Baudino et al. ("Baudino"). For at least the following reasons, these rejections are respectfully traversed.

Claim 16, as amended herein, recites:

A method for securing a lead in a deep brain stimulation system comprising the steps of:
providing a cannula with a lumen and a slit, the slit extending through a portion of a length of the cannula;
inserting a lead into the lumen of the cannula, the lead having an offset portion that extends laterally out of the cannula through the slit when the lead is inserted in the lumen; and
releasably securing the offset portion of the lead to the reference platform through the slit;
wherein the lead further includes a lumen along its length that does not extend through the offset portion.

(emphasis added).

In contrast, Baudino fails to teach or suggest a method of securing a lead in a deep brain stimulation system that includes inserting into the lumen of a cannula a lead having an offset portion and a lumen along its length that does not extend through the offset portion. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claim 16 and its dependent claims based on Baudino should be reconsidered and withdrawn.

Claims 10-11 were rejected as anticipated under 35 U.S.C. § 102(b) by Baudino, or in the alternative, under 35 U.S.C. § 103(a) as obvious over the teachings of Baudino. For at least the following reasons, these rejections are respectfully traversed.

AB-334U

10/642,851

Claim 10, as amended herein, recites:

A deep brain stimulation system comprising:
a cannula having a lumen and a slit, the slit extending through a portion of a length of the cannula;
a medical device dimensioned to be insertable within the lumen of the cannula and comprising an offset portion that extends laterally out of the cannula through the slit when the medical device is inserted in the lumen;
a reference platform for supporting at least a portion of the medical device;
wherein the medical device further comprises a lumen along its length that does not extend through the offset portion.
(emphasis added).

In contrast, Baudino fails to teach or suggest a medical device having an offset portion and a lumen along its length that does not extend through the offset portion. Rather, as shown in FIG. 15A of Baudino, the Baudino system includes a lead or catheter that does not have an offset portion as claimed. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Moreover, the 103(a) rejection is moot in light of the amendments made herein. Consequently, for at least these reasons, the rejection of claim 10 and its dependent claims based on Baudino should be reconsidered and withdrawn.

New Claims:

The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the independent claims from which they depend. Therefore, examination and allowance of the newly added claims is respectfully requested.

AB-334U

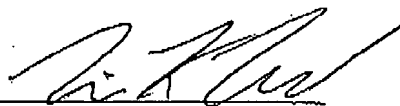
10/642,851

Conclusion:

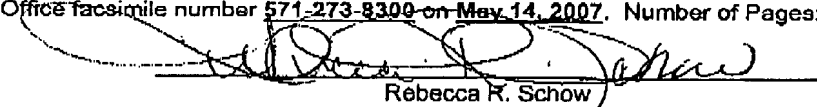
For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: May 14, 2007


Travis K. Laird
Registration No. 55,351

Travis K. Laird, Esq.
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)

| |
|---|
| <p style="text-align: center;">CERTIFICATE OF TRANSMISSION</p> <p>I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number <u>571-273-8300</u> on <u>May 14, 2007</u>. Number of Pages: <u>16</u></p>  <p style="text-align: center;">Rebecca R. Schow</p> |
|---|